APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,423	12/31/2003	Shankar Ramamurthy	49218.1200	9566

7590   10/06/2006

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EXAMINER
TRAN, MAI T

ART UNIT	PAPER NUMBER
2129	

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/749,423	RAMAMURTHY ET AL.
	Examiner	Art Unit	
	Mai T. Tran	2129	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>10 July 2006</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-16</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-16</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>10 July 2006</u> is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

REMARKS

Applicants' amendment dated July 10, 2006 responding to the March 8, 2006 Office

Action provided in the rejection of claims 1-16, wherein claims 1, 2, 10, and 14 have been

amended. Claims 1-16 remain pending in the application and which have been fully considered

by the examiner.

The Examiner withdraws the objection to the specification for the minor informalities

corresponding to Applicants' amendment.

The Examiner withdraws the rejection to claim 1-16 under 35 USC § 101, the rejection to

claims 1-16 under 35 USC § 112 corresponding to Applicants' amendment.

DRAWINGS

The drawings are objected to because of the minor informalities:

- Figure 3:

    ❖ The label of reference character 62 "Simulator and animator rapid training
      deployment" is not consistent with the specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to

the Office action to avoid abandonment of the application. Any amended replacement drawing

sheet should include all of the figures appearing on the immediate prior version of the sheet,

even if only one figure is being amended. The figure or figure number of an amended drawing

should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure

must be removed from the replacement sheet, and where necessary, the remaining figures must

be renumbered and appropriate changes made to the brief description of the several views of the

drawings for consistency. Additional replacement sheets may be necessary to show the

renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet"

pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The

objection to the drawings will not be held in abeyance.

CLAIM REJECTIONS - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making
and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
contemplated by the inventor of carrying out his invention.

Claims **1, 2, and 14** are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one skilled in the

relevant art that the inventor(s), at the time the application was filed, had possession of the

claimed invention.

❖   The new added limitation in claims 1, 2, and 14: "manual action" has not been

disclosed. Applicants have not described a particular method, technique, or

mechanism to determine a context of a user's actions wherein the action is

selected from manual action. What manual action are applicants referring to? Pull

a chair, pickup a phone, etc. and how do applicants determine a context from

these manual action? For example, do applicants videotaped user while they are

performing their tasks?

❖ The new added limitation in claim 2 "comparing a first set of the captured

business process data with a second set of the captured business process data" has

not been disclosed. Applicants have not described a particular method, technique,

or mechanism to compare a first set of captured data with a second set. For

example, do applicants compare them by matching keywords, or do applicants set

certain threshold, etc.

Applicants are required to indicate the exact portion or portions of the specification

providing the support for this limitation.

CLAIM REJECTIONS - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1-9 and 14-16** are rejected under 35 U.S.C. 102(b) as being anticipated by

Bullwinkel et al (U. S. Patent No. 6,099,317), hereafter Bullwinkel.

Claim **10** is rejected under 35 U.S.C. 102(b) as being anticipated by Ingoglia et al (U. S.

Patent No. 5,214,780) hereafter Ingoglia.

Claim 1

Bullwinkel teaches a method for object identification, comprising the steps of:

determining a context of a user's actions wherein the action is selected from the group of

manual action, computer-based action, or combinations thereof, wherein each action generates

business process data originating from a user input, by comparing a first set of the business

process data with a second set of the business process data (col. 5, lines 57-67, col. 6, lines 1-15,

col. 8, lines 46-49);

determining a final goal of the user's actions chosen from at least one intermediary goal

by mapping the context to the at least one intermediary goal (col. 5, lines 57-67, col. 6, lines 1-

15);

based on the context and the final goal, determining a path for the user to reach the goal

(col. 5, lines 57-67, col. 6, lines 1-15); and

determining process aids and guidance for use by the user to aid in reaching the goal (col.

5, lines 57-67, col. 6, lines 1-15).

Claim 2

Bullwinkel teaches a method for knowledge object generation and deployment in

connection with a computer utilizing software applications, comprising the steps of:

capturing an interaction of a user with a software application wherein the interaction is

selected from the group of manual interaction, computer-based interaction, or combinations

thereof, wherein each interaction generates a set of business process data (col. 2, lines 63-67, col.

3, lines 1-3);

modeling processes being performed by the user during the interactions (col. 5, lines 12-16);

generating knowledge content including (col. 5, lines 12-16, lines 23-25);

defining a context of the interaction by comparing a first set of the captured business process data with a second set of the captured business process data (col. 6, lines 3-6, col. 7, lines 47-67, col. 8, lines 1-10),

providing at least one of documentation and training relating to the process (col. 5, lines 23-25, col. 6, lines 13-15); and

deploying the knowledge content as knowledge objects to a user device (col. 5, lines 29-30, Examiner asserts knowledge objects as recorded events).

Claim 3

Bullwinkel teaches a method as claimed in claim 2, wherein said generating knowledge content includes providing best practices for the process (col. 2, lines 39-44).

Claim 4

Bullwinkel teaches a method as claimed in claim 2, wherein said deploying is through a web server to a browser of a user device (col. 5, lines 36-38).

Claim 5

Bullwinkel teaches a method as claimed in claim 2, further comprising the step of:

depositing said knowledge objects in a repository prior to said step of deploying (col. 10, lines 21-24).

Claim 6

Bullwinkel teaches a method as claimed in claim 5, further comprising the step of:

providing access to said repository by a developer (col. 7, lines 22-24, col. 8, lines 50-

53).

Claim 7

Bullwinkel teaches a method as claimed in claim 2, further comprising the step of:

incorporating third party content with said knowledge objects (col. 8, lines 50-53,

Examiner asserts third party content as other modes of operation).

Claim 8

Bullwinkel teaches a method as claimed in claim 2, further comprising the steps of:

providing said knowledge objects as templates (col. 5, lines 14-20); and

editing said templates (col. 7, lines 20-21, col. 10, lines 25-26).

Claim 9

Bullwinkel teaches a method as claimed in claim 8, wherein said editing of said templates

includes at least one of: sentence templates, document templates, offline templates, coach

templates and internet data transfer templates (col. 5, lines 14-20).

Claim 14

Bullwinkel teaches a system for knowledge object generation in connection with a

computer utilizing software applications, comprising:

process capture elements operable to capture an interaction with software applications

generated by at least one user's performance of a business process, wherein said capturing

includes capture of data generated by at least one action of the at least one user wherein the

action is selected from the group of manual action, computer-based action, and combinations

thereof as captured processes (col. 2, lines 63-67, col. 3, lines 1-3);

a storage connected to receive and store said captured process (col. 10, lines 21-24);

a knowledge object content layer connected to receive said captured processes from said storage for analysis of content (col. 8, lines 1-13);

a presentation layer connected to receive said content of said knowledge content layer to present said content as templates (col.5, lines 14-20); and

a deployment layer connected to receive said templates from said presentation layer and provide said templates to a user's device (col. 5, lines 36-38).

Claim 15

Bullwinkel teaches a system as claimed in claim 14, wherein said knowledge content layer includes at least one of the following:

an internet data transfer author to provide context definition (col. 5, lines 10-12);

an analyzer to provide process analysis (col. 8, lines 1-13),

a coach to provide knowledge provisioning as an interface (col. 6, lines 32-40),

a documentor to provide process documentation (col. 6, lines 47-54), and

a simulator to provide training presentations (col. 6, lines 13-15).

Claim 16

Bullwinkel teaches a system as claimed in claim 14, further comprising:

a repository connected to receive templates from said presentation layer and to provide said templates to said deployment layer (col.10. lines 21-24).

Claim 10

Ingoglia teaches a software developer's tool kit, comprising:

a tool kit for developers of software (col. 5, line 21), including:

a core technology component comprising a function selected from the group of

capture, inspect, track, notify, playback, and combinations thereof (col. 5, lines 19-28, col. 6,

lines 27-56);

a programming interface to a system (col. 5, lines 25-26); and

an interface to system process files (col. 5, lines 30-31).

CLAIM REJECTIONS - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in. section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

- **Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ingoglia

  as applied to claim 10 above, and further in view of "The Role of XML in Open

  Hypermedia Systems", by Jacco van Ossenbruggen et al, hereafter Van

  Ossenbruggen.

Ingoglia teaches a software developer's tool kit but fails to disclose system process files

are XML format.

Van Ossenbruggen teaches the use of XML as a data format for structured document

interchange on the Web and XML plays an important role in the development of open

hypermedia systems (abstract).

It would have been obvious at the time the invention was made to a person having

ordinary skill in the art to combine the software developer's tool kit of Ingoglia with the

XML format of Van Ossenbruggen. The motivation for doing so would be to introduce

hypermedia technology into as many applications and components of existing computing

environments as possible and to evolve current computing environments into a world-

wide, unified hypermedia environment spanning multiple computing platforms

(Introduction, lines 2-5).

- **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ingoglia

  and further in view of Van Ossenbruggen as applied to claims 10-11 above.

  Ingoglia teaches captured process files of a user performing a process (col. 1,

  lines 28-35).

- **Claim 13** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ingoglia in view of Van Ossenbruggen as applied to claims 10-12 above, and further in view of "A Model Driven Methodology for Business Process Engineering", by Bipin Chadha, hereafter Chadha.

Ingoglia and Van Ossenbruggen teach substantially all of applicants' claimed invention but fail to disclose process files of a to-be process.

Chadha teaches the development of to-be process (page 4, left col. 2nd paragraph).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the software developer's tool kit of Ingoglia with the XML format of Van Ossenbruggen and the development of to-be process of Chadha. The motivation for doing so would be to support an organization's migration to effective, agile and efficient processes (page 1, right col., 2nd paragraph), and the to-be process is a radical departure from the old process where problems exist (page 1, left col., 2nd paragraph).

RESPONSE TO ARGUMENTS

Applicants' arguments filed have been fully considered but they are not persuasive. Specifically, applicants argue that:

1. **Rejection under 35 U.S.C. §102**

   - *Claim 1: Bullwinkel does not anticipate each and every element of the claim. Bullwinkel is limited to recording events that occur within a single specific software application ... Furthermore, Bullwinkel's invention is business process un-aware. Moreover, bullwinkel does not and cannot determine user goals.*

Bullwinkel is not limited to recording events that occur within a *single* specific software

application as Applicants alleged. The cited "Description of related art paragraph 2" to support

this rationale is erroneous. The *single* target application was from another U. S. Patent that

Bullwinkel disclosed as the disadvantages of prior art.

During patent examination, the claims are given the broadest reasonable interpretation

consistent with the specification. See In re Morris, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir.

1997). Bullwinkel teaches in col. 2 different functions of the APR device to provide the ability

to dynamically interact with and monitor arbitrary computer applications. It could be used as

employee training tools, or it could be used to interpret events between operating system and

target applications. Examiner interprets employee-training tools, and events between operating

system and target applications are business process because definitely they are not for home use.

Bullwinkel teaches determining user goals at col. 6, lines 5-9. Moreover, Bullwinkel

teaches a variety of applications as responded above, therefore, if the user changes goal, for

instance "open a spreadsheet application" as applicants argued, Bullwinkel teaches that as well.

- *Claims 2-9: Bullwinkel does not anticipate each and every element of claim 2. As
  argued in association with claim 1 above, Bullwinkel is limited to recording
  events that occur within a specific software application, is incapable of recording
  manual tasks, and is business process un-aware.*

Examiner has responded above to the arguments regarding "within a specific software

application" and "business process un-aware". Bullwinkel teaches at col. 2, lines 39-44

recording manual tasks. Examiner asserts "the APR is used to monitor the efficient workers to

record the process by which they use the computer applications to perform their job" to read the

claimed limitation since workers keyboard input is interpreted as manual task.

- *Claims 14-16: Bullwinkel does not teach each and every element of claim 14. As argued in association with claim 1 above, Bullwinkel is limited to recording events that occur within a specific software application, is incapable of recording manual tasks, and is business process un-aware.*

Examiner has responded above to the arguments regarding "within a specific software application" and "business process un-aware". Bullwinkel teaches at col. 2, lines 39-44 recording manual tasks. Examiner asserts "the APR is used to monitor the efficient workers to record the process by which they use the computer applications to perform their job" to read the claimed limitation since workers keyboard input is interpreted as manual task.

- *Claim 10: Ingoglia does not teach each and every element of claim 10.*

Ingoglia anticipates the newly added limitation in claim 10. Please see above rejection.

2. Rejection under 35 U.S.C. §103

- *Claim 11: As argued above in association with claim 10, Ingoglia does not teach each and every element of claim 10 and thus claim 11 which depends therefrom ... Without more, there is no motivation to combine these references.*

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Applicants are directed to page 10 above of the Office Action where the teaching or suggestion to make the combination cited is found **within the prior art and not from Applicants' disclosure.** (Emphasis added).

- *Claim 12: As argued in association with claim 10 and 11 above, Ingoglia does not teach each and every element of claims 10-11 as amended and claim 12 which depends therefrom....each and every element of claim 12.*

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Applicants are directed to page 10 above of the Office Action where the teaching or suggestion to make the combination cited is found **within the prior art and not from Applicants' disclosure.** (Emphasis added).

- *Claim 13: As argued in association with claims 10-12 above, Ingoglia does not teach each and every element of claims 10-12 as amended and claim 12 which depends therefrom ... Moreover, no combination of Ingoglia and Chadha teaches each and every element of claim 13.*

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Applicants are directed to page 10 above of the Office Action where the teaching or suggestion to make the combination cited is found **within the prior art and not from Applicants' disclosure.** (Emphasis added).

On these basis, applicants' argument is found unpersuasive. Therefore, the rejections of

the claims STAND.

CONCLUSION

Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

CORRESPONDENCE INFORMATION

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Mai T. Tran whose telephone number is (571) 272-4238. The

examiner can normally be reached on M-F 9:00am-- 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David Vincent can be reached on 571-272-3080. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M.T.T   David Vincent
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